



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/146,069	09/02/1998	TAKEHIRO YOSHIDA	1232-4467	6726

7590 11/19/2002

MORGAN & FINNEGAN
345 PARK AVENUE
NEW YORK, NY 10154

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/146,069	YOSHIDA, TAKEHIRO
	Examiner	Art Unit
	Joseph R. Pokrzywa	2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 10 September 2002 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-25 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6) Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 9/10/02, and has been entered and made of record. Currently, **claims 1-25** are pending.

Response to Arguments

2. Applicant's arguments with respect to **claims 1-11** have been considered but are moot in view of the new ground(s) of rejection.
3. Applicant's arguments regarding **claims 12-25**, filed 9/10/02, have been fully considered but they are not persuasive.
4. In response to applicant's arguments regarding the rejection of **claims 20-25**, which were rejected in the Office action dated 6/12/02, as being anticipated by Mordowitz *et al.* (U.S. Patent Number 6,011,794), which state on page 8 that Mordowitz fails to teach of notifying the recipient that data has been sent over the Internet. The examiner notes that independent claims 20 and 22 do not specifically include this limitation. Particularly, claim 20 recites "notification means for notifying a recipient, by a method different from that of the transmission means, that the transmission means has executed transmission of the facsimile data via the Internet, prior to the recipient accessing the Internet." Similarly, claim 22 recites "wherein the sending operation of the second means indicates that the first means has executed transmission of the facsimile data over the first communication network to said recipient, prior to the recipient accessing said second communication network." The phrase "has executed transmission" is different than the

phrase "has been sent". Mordowitz teaches of notifying a recipient (in step 98 in Fig. 4, column 4, lines 21 through 36), by a method different from that of the transmission means (POTS call, "no" in step 96), that the transmission means has executed transmission of the facsimile data via the Internet, prior to the recipient accessing the Internet (step 94 in Fig. 4, column 4, lines 10 through 20, wherein the transmission of the facsimile data via the Internet was executed, but could not be completed since the remote modem was not logged onto the Internet).

5. Therefore, the rejection of **claims 20-25**, as cited in the Office action dated 6/12/02, under 35 U.S.C. 102(e), as being anticipated by Mordowitz *et al.*, is maintained and repeated in this Office action.

6. In response to applicant's arguments regarding the rejection of **claims 12, 18, and 19**, which were rejected in the Office action dated 6/12/02, as being unpatentable over Mordowitz *et al.* (U.S. Patent Number 6,011,794) in view of Williams *et al.* (U.S. Patent Number 6,192,045), and further in view of Bloomfield (U.S. Patent Number 6,025,931), which states on page 11 that Bloomfield fails to teach if the connection to the PSTN is for any type of notification, let alone a notification that a facsimile communication over the Internet has been sent. The examiner notes that independent claims 12, 18, and 19 do not specifically include this limitation. Particularly, claim 12 recites "notification means for calling the station B from the station A, when the dial-up connection is established, notifying the station B via a PSTN that facsimile communication is being sent through the Internet and description information of the facsimile communication executed through the Internet, prior to station B accessing the Internet", with similar limitations in claims 18 and 19. The phrase "is being sent" is required by the current claim, and not "has

been sent", as argued by applicant. Mordowitz teaches of a means for calling the station B from the station A, when the dial-up connection is established, notifying the station B via a telephone line (POTS, see Figs. 1 and 4) that facsimile communication is being sent through the Internet and description information of the facsimile communication executed through the Internet (step 98 in Fig. 4, column 4, lines 21 through 36, wherein step 98 notifies the recipient that a facsimile communication is being sent through the Internet in step 94), prior to station B accessing the Internet (step 100 in Fig. 4, column 4, line 22 through 36). However, Mordowitz does fail to teach of notifying the station B *via the PSTN*. Williams discloses a communication apparatus (fax call-back device 53, seen in Figs. 9-11), with a control method (see Fig. 12), capable of facsimile communication through the Internet (see Figs. 9-11) by dial-up connection (see steps 77 through 80 in Fig. 12), comprising means for calling the station B from the station A, notifying the station B via the PSTN (see step 82 in Fig. 12). Because of this, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Williams in the system of Mordowitz, as the systems share cumulative features, being additive in nature.

7. Therefore, the rejection of **claims 12, 13, 18, and 19**, as cited in the Office action dated 6/12/02, under 35 U.S.C. 103(a), as being unpatentable over Mordowitz *et al.* in view of Williams *et al.*, and further in view of Bloomfield, is maintained and repeated in this Office action. Similarly, for the same reasons discussed above, the rejections of **claims 14-16 and claim 17**, as cited in the Office action dated 6/12/02, under 35 U.S.C. 103(a), as being unpatentable over Mordowitz *et al.* in view of Williams *et al.*, further in view of Bloomfield, and

further in view of Bobo, II and Wegner *et al.*, respectively, are maintained and repeated in this Office action.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. **Claims 1-3, 5, and 7-11** are rejected under 35 U.S.C. 102(e) as being anticipated by Picard *et al.* (U.S. Patent Number 6,233,318).

Regarding **claims 1 and 9**, Picard discloses a communication apparatus (integrated messaging system 106) and method comprising a means for performing facsimile communication through the Internet by dial-up connection (column 6, lines 29 through 34, and column 9, lines 11 through 46), and means for notifying a recipient using a PSTN (104) that a facsimile has been sent through the Internet (column 11, lines 43 through 59), prior to the recipient accessing the Internet (column 9, line 40 through column 10, line 6).

Regarding ***claims 2 and 10***, Picard discloses a communication apparatus (integrated messaging system 106) and a control method for the communication apparatus comprising means for performing facsimile communication through the Internet by dial-up connection (column 6, lines 29 through 34, and column 9, lines 11 through 46), and means for, in response to a notification, from a calling party communication apparatus (column 7, line 29 through column 8, line 9) using a PSTN (104), that the calling party communication apparatus has sent a facsimile to the communication apparatus through the Internet, setting up connection to the Internet by dial-up connection (column 11, lines 37 through 65) and receiving facsimile communication information through the Internet by Post Office Protocol (column 12, lines 11 through 33).

Regarding ***claim 3***, Picard discloses the system discussed above in claim 1, and further teaches of a means for selecting on the basis of a user operation whether the communication is an important communication (column 6, line 48 through column 7, line 19), and wherein when the important communication is not selected, the notification means do not notify using a PSTN that the facsimile is being sent through the Internet (column 11, line 43 through column 12, line 28).

Regarding ***claims 5 and 11***, Picard discloses a communication apparatus (integrated messaging system 106) and control method capable of facsimile communication through the Internet by dial-up connection (column 6, lines 29 through 34, and column 9, lines 11 through 46), comprising a means for, in response to a notification, from a calling party communication apparatus (column 7, line 29 through column 8, line 9) using a PSTN (104) that the calling party communication apparatus has sent a facsimile to the communication apparatus through the Internet (column 11, lines 37 through 65), displaying information representing that the calling

party communication apparatus has sent a facsimile to the communication apparatus through the Internet and station address information of a calling party (column 7, line 13 through column 8, line 9), means for determining on the basis of selection by a user whether the communication apparatus is to set up connection to the Internet by dial-up connection (column 11, lines 37 through 65) to receive facsimile communication information through the Internet by Post Office Protocol (column 12, lines 11 through 33).

Regarding *claim 7*, Picard discloses the apparatus discussed above in claim 5, and further teaches that when dial-up connection is performed to receive the facsimile communication information through the Internet, all pieces of facsimile communication information received by a service provider are received (column 9, lines 11 through 39).

Regarding *claim 8*, Picard discloses the apparatus discussed above in claim 5, and further teaches of display means for, in response to the notification (column 11, lines 37 through 50), displaying a list of communication management information independently of communication management information associated with normal transmission/reception (column 7, lines 13 through 28), and displaying whether reception of the facsimile communication information from the service provider is complete (column 6, line 35 through column 7, line 40).

10. **Claims 20-25** are rejected under 35 U.S.C. 102(e) as being anticipated by Mordowitz *et al.* (U.S. Patent Number 6,011,794, cited in the Office action dated 6/12/02).

Regarding *claim 20*, Mordowitz discloses a communication apparatus (ITA 10) comprising means for transmitting facsimile data via the Internet (see abstract, and column 4, lines 10 through 20, and column 5, lines 45 through 55), and means (step 98 in Fig. 4, column 4,

lines 21 through 36) for notifying a recipient, by a method different from that of the transmission means (POTS call, “no” in step 96), that the transmission means has executed transmission of the facsimile data via the Internet, prior to the recipient accessing the Internet (step 94 in Fig. 4, column 4, lines 10 through 20, wherein the transmission of the facsimile data via the Internet was executed, but could not be completed since the remote modem was not logged onto the Internet).

Regarding *claim 21*, Mordowitz discloses the apparatus discussed above in claim 20, and further teaches that the transmission means transmits the data through the Internet (see Fig. 1), and the notification means transmits notification through a public telephone network (conventional long distance telephone lines 12 via public exchange switches 15, seen in Fig. 1).

Regarding *claim 22*, Mordowitz discloses a communication apparatus (ITA 10) comprising first means (Internet connect processing 64 software, and Internet communication protocol 68 software, seen in Fig. 3) for sending facsimile data over a first communication network (Internet, see Fig. 1) to a recipient (see abstract, and column 4, lines 10 through 20, and column 5, lines 45 through 55), second means (Internet call setup 76 software, seen in Fig. 3) for sending data over a second communication network (long distance telephone network, seen in Fig. 1) to the recipient (column 4, lines 27 through 36), and third means (master program 60, seen in Fig. 3) for controlling the first means and the second means (column 3, line 65 through column 4, line 9), wherein the third means controls the second means so as to send data (step 98 in Fig. 4, column 4, lines 21 through 36) corresponding to sending operation of the first means (see Fig. 4), and wherein the sending operation of the second means indicates that the first means has executed transmission of the facsimile data over the first communication network to the recipient, prior to the recipient accessing the second communication network (step 94 in Fig. 4,

column 4, lines 10 through 20, wherein the transmission of the facsimile data via the Internet was executed, but could not be completed since the remote modem was not logged onto the Internet).

Regarding *claim 23*, Mordowitz discloses the apparatus discussed above in claim 22, and further teaches that the first communication network (Internet) is a facsimile communication network (see abstract).

Regarding *claim 24*, Mordowitz discloses the apparatus discussed above in claim 22, and further teaches that the second communication network is a telephone network (conventional long distance telephone lines 12 via public exchange switches 15, seen in Fig. 1).

Regarding *claim 25*, Mordowitz discloses the apparatus discussed above in claim 22, and further teaches that the data sent by the second means is a part of data sent by the first means (column 4, lines 27 through 31).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 4 and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Picard *et al.* (U.S. Patent Number 6,233,318), and further in view of Cooper *et al.* (U.S. Patent Number 6,052,442, cited in the Office action dated 6/12/02).

Regarding *claim 4*, Picard discloses the apparatus discussed above in claim 2, but fails to particularly teach of a means for registering a time of execution of POP processing on the basis

of a user operation. Cooper discloses a communication apparatus (Internet answering machine seen in Fig. 1) and a control method for the communication apparatus comprising a means for performing facsimile communication (column 6, lines 38 through 40) through the Internet (column 1, lines 41 through 56) by dial-up connection (step 74 in Fig. 3, and step 94 in Fig. 5, column 10, lines 40 through 43), and means for, in response to a notification (column 6, lines 16 through 29, and column 7, lines 2 through 14), from a calling party communication apparatus (service provider central computer, column 1, lines 41 through 48, which is calling the communication apparatus, column 2, lines 57 through column 3, line 4, and steps 46 and 54 in Fig. 2-1) using a telephone line (5, column 4, lines 30 through 47, seen in step 54 in Fig. 2-1, or step 80 in Fig. 3, column 8, lines 21 through 38), setting up connection to the Internet by dial-up connection (step 94 in Fig. 5, column 10, lines 25 through 55) and receiving facsimile communication information through the Internet by POP (column 1, lines 41 through 67, and column 10, lines 43 through 64). Cooper further teaches of a means for registering a time of execution of POP processing on the basis of a user operation (step 70 in Fig. 3, column 8, lines 14 through 20), and wherein the reception means set up connection to the Internet at the registered time and receive the facsimile communication information through the Internet by POP ("yes" branch of step 72, leading to steps 74, 76, and 80, column 8, lines 20 through 38). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Cooper's teachings in the system of Picard. Picard's system would become more user-friendly with the addition of Cooper's teachings, as the users would be able to select when to connect to the Internet to receive facsimile messages, as recognized by Cooper.

Regarding **claim 6**, Picard discloses the apparatus discussed above in claim 5, but fails to particularly teach of a means for registering whether, in response to the notification, dial-up connection is to be immediately performed on the basis of the station address of the calling party communication apparatus to receive the facsimile communication information through the Internet by POP. Cooper discloses a communication apparatus (Internet answering machine seen in Fig. 1) and control method capable of facsimile communication (column 6, lines 38 through 40) through the Internet (column 1, lines 41 through 56) by dial-up connection (step 74 in Fig. 3, and step 94 in Fig. 5, column 10, lines 40 through 43), comprising a means (display of pager) for, in response to a notification (being steps 55 and 57, having the paging option selected), from a calling party communication apparatus (service provider central computer, column 1, lines 41 through 48, which is calling the communication apparatus, column 2, lines 57 through column 3, line 4, and steps 46 and 54 in Fig. 2-1) using a telephone call (column 7, lines 4 through 10, through the pager of step 55) that the calling party communication apparatus (service provider) is sending a facsimile to the communication apparatus (column 7, lines 1 through 14, wherein an indication that a message has been received at the service provider, and a portion of the e-mail message is being sent to the Internet answering machine, as seen in step 54, column 6, lines 50 through 65, and column 10, lines 25 through 39), displaying information representing a facsimile and station address information of a calling party (column 7, lines 7 through 14, wherein the header of each e-mail message inherently includes address information of a calling party), means for determining on the basis of selection by a user whether the communication apparatus is to set up connection to the Internet by dial-up connection (step 94 in Fig. 5, column 10, lines 25 through 55) to receive facsimile communication information through the Internet by POP

(column 1, lines 41 through 67, and column 10, lines 43 through 64). Further, Cooper teaches of a means for registering whether, in response to the notification (steps 55-59 in Fig. 2-2), dial-up connection is to be immediately performed on the basis of the station address of the calling party communication apparatus (column 9, lines 40 through 49, and column 5, lines 54 through 66, step 46 in Fig. 2-1) to receive the facsimile communication information through the Internet by POP (column 1, lines 41 through 67, and column 10, lines 43 through 64). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Cooper's teachings in the system of Picard. Picard's system would become more user-friendly with the addition of Cooper's teachings, as the users would be able to select when to connect to the Internet to receive facsimile messages, as recognized by Cooper.

13. **Claims 12, 13, 18, and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mordowitz *et al.* (U.S. Patent Number 6,011,794, cited in the Office action dated 6/12/02) in view of Williams *et al.* (U.S. Patent Number 6,192,045, cited in the Office action dated 6/12/02), and further in view of Bloomfield (U.S. Patent Number 6,025,931, cited in the Office action dated 6/12/02).

Regarding **claims 12 and 18**, Mordowitz discloses a communication apparatus (first ITA 10), with a control method, capable of facsimile communication through the Internet (90, see Fig. 1, and abstract) by dial-up connection (column 4, lines 10 through 20), comprising means for performing dial-up connection from a station A (calling telephone 16) to an Internet service provider (ISP 11) to execute communication with a station B (second ITA 20, see Figs. 1 and 4, steps 82 through 92) **having an e-mail address** through the Internet (see Fig. 1), and means for

calling the station B from the station A, when the dial-up connection is established, notifying the station B *via a telephone line* (POTS, see Figs. 1 and 4) that facsimile communication is being sent through the Internet and description information of the facsimile communication executed through the Internet (step 98 in Fig. 4, column 4, lines 21 through 36), prior to station B accessing the Internet (step 100 in Fig. 4, column 4, line 22 through 36).

However, Mordowitz fails to specifically teach of notifying the station B *via the PSTN*. Williams discloses a communication apparatus (fax call-back device 53, seen in Figs. 9-11), with a control method (see Fig. 12), capable of facsimile communication through the Internet (see Figs. 9-11) by dial-up connection (see steps 77 through 80 in Fig. 12), comprising means for performing dial-up connection from a station A (fax call back device 53) to an Internet service provider (ISP 57) to execute communication with a station B (fax call back device 54) through the Internet (see Fig. 11), and means for calling the station B from the station A, notifying the station B via the PSTN (see step 82 in Fig. 12) that facsimile communication is being sent through the Internet (column 8, line 61 through column 9, line 9), prior to the station B (fax call-back device 54) accessing the Internet (column 9, lines 4 through 20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Williams in the system of Mordowitz. Mordowitz's system would easily be modified with Williams' teachings, as the systems share cumulative features, being additive in nature, therein conforming to well known standards of having a PSTN be a standard telephone network.

Continuing, Mordowitz and Williams do not specifically teach if station B has a TCP/IP address, as the station has an e-mail address. Bloomfield discloses a communication apparatus

(fax interface device 102) capable of facsimile communication through the Internet (email network 116), comprising means for performing dial-up connection from a station A (fax device 106) to an Internet service provider (e-mail server 112) to execute communication with a station B (e-mail device 118) *having a TCP/IP address* through the Internet (column 7, lines 35 through 53). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Mordowitz and Williams's system. Mordowitz and Williams's system would easily be implemented with Bloomfield's teachings, as an e-mail address is well known within the art to be a TCP/IP address, as recognized by Bloomfield, thereby conforming to industry standards.

Regarding **claim 13**, Mordowitz, Williams, and Bloomfield disclose the apparatus discussed above in claim 12, and Mordowitz further teaches that the description information is summarized text representing a summary of facsimile communication column 6, lines 11 through 24, wherein the intended telephone number is summarized text).

Regarding **claim 19**, Mordowitz discloses a computer readable storage medium (ROM 28, column 3, lines 26 through 31) which stores a program (program 60, seen in Fig. 3, column 3, line 65 through column 4, line 9) for controlling a communication apparatus (first ITA 10), with a control method, capable of facsimile communication through the Internet (90, see Fig. 1, and abstract) by dial-up connection (column 4, lines 10 through 20), comprising code for establishing a dial-up connection from a station A (calling telephone 16) to an Internet service provider (ISP 11) to execute communication with a station B (second ITA 20, see Figs. 1 and 4, steps 82 through 92) *having an e-mail address* through the Internet (see Fig. 1), and code for calling the station B from the station A, when the dial-up connection is established, notifying the

station B *via a telephone line* (POTS, see Figs. 1 and 4) that facsimile communication is being sent through the Internet and description information of the facsimile communication executed through the Internet (step 98 in Fig. 4, column 4, lines 21 through 36), prior to the station B accessing the Internet (step 100 in Fig. 4, column 4, line 22 through 36).

However, Mordowitz fails to specifically teach of notifying the station B *via the PSTN*. Williams discloses a communication apparatus (fax call-back device 53, seen in Figs. 9-11), with a control method (see Fig. 12), capable of facsimile communication through the Internet (see Figs. 9-11) by dial-up connection (see steps 77 through 80 in Fig. 12), comprising means for performing dial-up connection from a station A (fax call back device 53) to an Internet service provider (ISP 57) to execute communication with a station B (fax call back device 54) through the Internet (see Fig. 11), and means for calling the station B from the station A, notifying the station B via the PSTN (see step 82 in Fig. 12) that facsimile communication is being sent through the Internet (column 8, line 61 through column 9, line 9), prior to the station B (fax call-back device 54) accessing the Internet (column 9, lines 4 through 20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Williams in the system of Mordowitz. Mordowitz's system would easily be modified with Williams' teachings, as the systems share cumulative features, being additive in nature, therein conforming to well known standards of having a PSTN be a standard telephone network.

Continuing, Mordowitz and Williams do not specifically teach if station B has a TCP/IP address, as the station has an e-mail address. Bloomfield discloses a communication apparatus (fax interface device 102) capable of facsimile communication through the Internet (email

network 116), comprising means for performing dial-up connection from a station A (fax device 106) to an Internet service provider (e-mail server 112) to execute communication with a station B (e-mail device 118) *having a TCP/IP address* through the Internet (column 7, lines 35 through 53). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Mordowitz and Williams's system. Mordowitz and Williams's system would easily be implemented with Bloomfield's teachings, as an e-mail address is well known within the art to be a TCP/IP address, as recognized by Bloomfield, thereby conforming to industry standards.

14. **Claims 14 through 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mordowitz *et al.* (U.S. Patent Number 6,011,794, cited in the Office action dated 6/12/02) in view of Williams *et al.* (U.S. Patent Number 6,192,045, cited in the Office action dated 6/12/02), further in view of Bloomfield (U.S. Patent Number 6,025,931, cited in the Office action dated 6/12/02), and further in view of Bobo, II (U.S. Patent Number 5,675,507, cited in the Office action dated 6/12/02).

Regarding **claim 14**, Mordowitz, Williams, and Bloomfield disclose the apparatus discussed above in claim 12, but fail to specifically teach if the description information is information of a first page of facsimile information transmitted through the Internet. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when

communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37). Further, Bobo teaches that the description information is information of a first page of facsimile information transmitted through the Internet (column 9, lines 2 through 17). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bobo's teachings in Mordowitz's system. Mordowitz's system would become more user friendly if adapted to incorporate Bobo's teachings, as the user would be able to quickly scroll through cover pages of transmitted messages, without downloading the entire message.

Regarding *claim 15*, Mordowitz, Williams, and Bloomfield disclose the apparatus discussed above in claim 12, but fail to specifically teach of transmitting a number of pages of facsimile information transmitted through the Internet and a communication time. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37). Further, Bobo teaches that the notification means further transmits the number of pages of facsimile

information transmitted through the Internet (column 8, lines 53 through 60) and a communication time (column 8, lines 53 through 60). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bobo's teachings in Mordowitz's system. Mordowitz's system would become more user friendly if adapted to incorporate Bobo's teachings, as the user would be able to determine display options based on the number of pages of transmitted facsimile messages, and the communication time, without downloading the entire message.

Regarding *claim 16*, Mordowitz, Williams, and Bloomfield disclose the apparatus discussed above in claim 12, but fail to specifically teach of a means for selecting, as the description information to be transmitted, either summarized text representing a summary of facsimile communication or information of a first page of facsimile information transmitted through the Internet. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37). Further, Bobo teaches of a means for selecting, as the description information to be transmitted, either summarized text representing a summary of facsimile communication (column 8, lines 53 through 63) or information of a first page of

facsimile information transmitted through the Internet (column 9, lines 2 through 30). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bobo's teachings in Mordowitz's system. Mordowitz's system would become more user friendly if adapted to incorporate Bobo's teachings, as the user would be able to determine display options, without downloading the entire message.

15. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Mordowitz *et al.* (U.S. Patent Number 6,011,794, cited in the Office action dated 6/12/02) in view of Williams *et al.* (U.S. Patent Number 6,192,045, cited in the Office action dated 6/12/02), further in view of Bloomfield (U.S. Patent Number 6,025,931, cited in the Office action dated 6/12/02), and further in view of Wegner *et al.* (U.S. Patent Number 5,712,907, cited in the Office action dated 6/12/02).

Regarding **claim 17**, Mordowitz, Williams, and Bloomfield disclose the apparatus discussed above in claim 12, and Mordowitz further teaches of a means for transmitting the facsimile information from the station A to the station B through the general public network without performing communication by the Internet communication execution means (see Fig. 4, "no" branch of step 84, leading to steps 86 and 88, column 4, lines 21 through 35). However, Mordowitz, Williams, and Bloomfield fail to teach of transmitting the facsimile information through the general public network when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value. Wegner discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (column 4, lines 7 through 11),

comprising means for performing dial-up connection from a station A (message communicating device 2s) to an Internet service provider (network node 6s) to execute communication with a station B (message communicating devices 1r, 2r, or 3r) having a TCP/IP address through the Internet (column 8, lines 31 and 32, and column 13, line 64 through column 14, line 3), and means for, when communication by the Internet communication execution means has been executed, calling the station B (recipient 8r in Fig. 7a) using a general public network (PSTN 5) to transmit information representing that facsimile communication has been executed through the Internet and description information of the facsimile communication executed through the Internet (column 3, lines 52 and 53). Further, Wegner teaches of a means (least cost routing processor 103) for, when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value (column 10, lines 21 through 23, and column 12, lines 59 through 62, wherein the number of pages of the message corresponds to the size of the message), transmitting the facsimile information from the station A to the station B through the general public network (PSTN 5) without performing communication by the Internet communication execution means (column 3, lines 54 65, and column 7, lines 25 through 62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Wegner's teachings in Mordowitz's system, thereby having a means for transmitting the facsimile information from the station A to the station B through the general public network without performing communication by the Internet communication execution means when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value. Mordowitz's system would become more

efficient if adapted to incorporate Wegner's teachings, as the most cost effective transmission would be selected to route the facsimile message.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J.R.P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp
November 14, 2002

Anthony Nguyen
MADELINE NGUYEN
PATENT EXAMINER

AN 2622